

Serial No. 09/901,878
Amdt. dated April 5, 2004
Reply to Office Action of February 3, 2004

Attorney Docket No. LX00071

REMARKS/ARGUMENTS

Claims 54 through 60 remain in this application. Claims 1 through 5 have been canceled without prejudice or disclaimer.

Claims 54 through 60 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the above Action states that the specification and drawings do not describe an input area configured to solely receive and display handwritten input, since FIG. 1 shows an input area 104 that accepts and displays handwritten input whereas FIG. 2 shows an input area that does not accept or display handwritten input.

Claim 54 provides, *inter alia*, "a circuit configured to provide a *window* for solely receiving and displaying handwritten data" [emphasis added]. Unlike claim 1 (which is hereby canceled), claim 54 is not directed to a predetermined area of the screen. Claim 54 provides a window that may be shown at a particular location of the screen as represented by FIG. 1 or not shown at the particular location of the screen as represented by FIG. 2. As supported by page 9, lines 5 through 14, of the specification, FIG. 2 is a representation of a different mode of the user interface showing a QWERTY keyboard in the input area and a word correction window. Therefore, claim 54 complies with the written description requirement of 35 U.S.C. §112, first paragraph. Claims 55 through 60 depend from and include all limitations of independent claim 54 and, thus, these dependent claims also comply with the written description requirement of 35 U.S.C. §112, first paragraph. In view of the above, reconsideration and withdrawal of the 35 U.S.C. §112, first paragraph, rejection of claims 54 through 60 are respectfully requested.

Serial No. 09/901,878
Amdt. dated April 5, 2004
Reply to Office Action of February 3, 2004

Attorney Docket No. LX00071

Claims 54 through 60 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,367,453 to Capps, et al. ("Capps, et al. patent") and U.S. Patent No. 5,838,302 to Kuriyama, et al. ("Kuriyama, et al. patent").

As stated above, claim 54 provides, *inter alia*, "a circuit configured to provide a window for solely receiving and displaying handwritten data". In rejecting claim 54, the above Action references FIG. 4a of the Capps, et al. patent. Also, in the Response to Applicants' Amendment and Arguments section of the above Action, the above Action states that note area 54a of the Capps, et al. patent is configured to solely receive and display handwritten input.

Applicants respectfully traverse the Examiner's rejection of claims 54 through 60. In particular, the Capps, et al. patent and the Kuriyama, et al. patent do not describe or suggest a window for solely receiving and displaying handwritten data, as required by independent claim 54. FIG. 4a and corresponding description of col. 8, lines 23 through 40 show that the screen 52 may receive and display handwritten data but do not show that the screen may *solely* receive and display handwritten data. Likewise, FIG. 2 and corresponding description of col. 5, line 30, through col. 7, line 38, describe a note area that may receive and display handwritten data but do not describe a note area that may *solely* receive and display handwritten data.

In fact, FIG. 3 and corresponding description at col. 7, line 39, through col. 8, line 22, teach away from the above language of claim 54. A decision step 80, shown in FIG. 3., determines whether a stylus has made a gesture on the screen. "Gesture" is defined by the Capps, et al. patent as anything from a simple click or tap on the screen to a complex but recognizable stroke on the screen, thus includes data other than handwritten data. In addition, the Capps, et al.

Serial No. 09/901,878
Amdt. dated April 5, 2004
Reply to Office Action of February 3, 2004

Attorney Docket No. LX00071

patent states, in reference to step 80, that "[a] preferred correction gesture associated with a word object comprises a double tap of the stylus on the screen 52 within the bounding box of the word object". Accordingly, the Capps, et al. patent describes a bounding box that displays handwritten data and may receive data other than handwritten data, i.e., a gesture. Therefore, claim 54 distinguishes patentably from the Capps, et al. patent., the Kuriyama, et al. patent, and the combination of these patents.

Claims 55 through 60 depend from and include all limitations of independent claim 54. Therefore, claims 55 through 60 distinguish patentably from the Capps, et al. patent., the Kuriyama, et al. patent, and the combination of these patents for the reasons stated above for independent claim 54.

In view of the above, reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection of claims 54 through 60 are respectfully requested.

CONCLUSION

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. Also, no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Commissioner is hereby authorized to deduct any additional fees arising as a result of this response, including any fees for Extensions of Time, or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

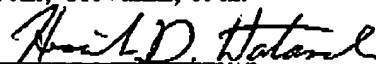
Serial No. 09/901,878
Amdt. dated April 5, 2004
Reply to Office Action of February 3, 2004

Attorney Docket No. LX00071

It is submitted that the claims clearly define the invention, are supported by the specification and drawings, and are in a condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Should the Examiner have any questions or concerns that may expedite prosecution of the present application, the Examiner is encouraged to telephone the undersigned.

Please forward all correspondence to:
Motorola, Inc.
Law Department (HDW)
600 North US Highway 45, AS437
Libertyville, IL 60048

Respectfully submitted,
Seni, Giovanni, et al.


Hisashi D. Watanabe
Attorney for Applicant(s)
Registration No. 37,465
Telephone: (847) 523-2322
Facsimile: (847) 523-2350

04/05/04

Date